REMARKS

By this paper, claim 3 was deleted and claims 1, 4, 5, 6, and 14 were amended. Claims 1 and 14 were amended to further clarify the basketball backboard assembly is "sized and configured for playing the game of basketball." Claims 1 and 14 were amended to clarify the elastomeric adhesive applied to the acrylic backboard and frame structure. Support for these amendments is found in the specification, page 1, line 12 to page 2, line 2, page 3, lines 15-24, and several original claims, including claims 3 and 14. The dependency of claims 4, 5, and 6 was corrected. Applicant respectfully requests favorable reconsideration of the pending claims.

Section 102(b) or 103(a) Rejection based upon Nunes. Paragraph 2 of the Office Action rejected claim 1 under Section 102(b) of the Patent Act as being anticipated by Nunes (U.S. Pat. No. 5,677,896) or in the alternative, as being unpatentable under Section 103(a) based upon the disclosure of Nunes. The rejection under Section 102(b) was addressed and overcome in Applicant's Response dated November 14, 2000, which is incorporated by reference. Regarding the rejection under Section 103(a), Applicant submits that the pending claims would not have been obvious from the disclosure of Nunes.

Section 103(a) requires examination of the claimed "subject matter as a whole." MPEP 2143.03 further states:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royaka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In this case, the ***all of the claim limitations*** are NOT taught or suggested by Nunes. Since many of the limitations of claim 1 are neither taught nor suggested by Nunes, claim 1 is not properly rejected under Section 103(a) based upon Nunes.

Claim 1 is drawn to a "basketball backboard assembly sized and configured for playing the game of basketball." In contrast, Nunes discloses a novelty desk lamp. One skilled in the art would immediately appreciate that the Nunes desk lamp does not teach or

suggest a basketball backboard assembly sized and configured to playing the game of basketball.

Claim 1 requires "a backboard frame structure having a bonding surface" and "an acrylic backboard having a bonding surface." Applicant could not find a disclosure or teaching in Nunes of a backboard frame structure having a bonding surface, an acrylic backboard having a bonding surface, and a catalyzed elastomeric adhesive sandwiched between the frame and the backboard. Therefore, applicant submits that claim 1 would not have been obvious from the teachings or suggestions of Nunes.

Nunes does not disclose or suggest acrylic backboards. The word "acrylic" is not even found in Nunes. The Office Action erroneous argues that Nunes' teaching of a "plastic" miniature basketball backboard is a disclosure of an acrylic backboard. Acrylic backboards may be plastic, but plastic backboards may NOT be acrylic. Disclosing a genus does not disclose a species. Given that acrylic basketball backboards are neither taught nor suggested by Nunes, claim 1 was not properly rejected under Section 103(a).

A separate backboard frame structure is not taught or suggested by Nunes. Nunes discloses a simulated foam strip (70) affixed to the backboard face, but the foam strip (70) is not a backboard frame structure. Nunes also discloses a magnet (69) affixed to the backboard, but again, the magnet (69) is not a backboard frame structure.

The catalyzed elastomeric adhesive of the applicant's invention is similarly not taught or suggested by Nunes. This element is important to the applicant's invention since the bond between the backboard and the frame should be both flexible and durable. (Specification, page 1, beginning at line 21.) Nunes teaches away from the use of catalyzed elastomeric adhesives, listing first a magnet as the mounting means, then listing a permanent adhesive only as part of a list of such means including suction cups, repositional adhesive, hooks, or hook receiving holes, none of which can be considered a catalyzed elastomeric adhesive. These listed mounting means do not have the durable and flexible characteristics and the quick set times of the catalyzed elastomeric adhesives taught in the instant application.

Finally, Nunes fails to teach or suggest the use of the bonding surfaces found both on a surface of the backboard and the frame of the instant invention. These elements are important to successful use of the disclosed catalyzed elastomeric adhesives because

bonding surface preparation affects adhesion. Since each of the above elements of the instant invention are neither taught nor suggested by Nunes, claim 1 was not properly rejected under Section 103(a). Withdrawal of the rejection of claim 1 is requested.

Section 102(b) or 103(a) Rejection based upon Hying. Paragraph 2 of the Office Action also rejected claim 1 under Section 102(b) of the Patent Act as being anticipated by Hying et al. (U.S. Pat. No. 5,839,982) or in the alternative, as being unpatentable under Section 103(a) based upon the disclosure of Hying. Hying et al. discloses a frame, an acrylic backboard, and "a double-sided adhesive layer," i.e., tape. Hying, col. 2, lines 15-16. Applicant submits that claim 1 is neither anticipated nor obvious from the disclosure os Hying.

Initially, the claimed basketball backboard assembly includes a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the acrylic backboard bonding surface. Hying fails to teach or suggest a catalyzed elastomeric adhesive as claimed.

According to MPEP 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claims." MPEP 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Since each and every element set forth in the claim is not found either expressly or inherently described by Hying, claim 1 is not anticipated. Withdrawal of the rejection is respectfully requested.

Based upon the discussion with Examiner Chambers, Applicant understands the rejection under Section 103(a) is based on the assumption that it would have been obvious to substitute the double-sided tape of Hying et al. with elastomeric adhesive. According to the Office Action, support for this assumption is found in Machida, column 3, lines 43-45 (Figures 9 and 10), which states: "the face lens 16 is secured at the top thereof to the rear spoiler 11 at the top of the notch 14 using a *double-sided tape* 23, a bolding agent, *or the like*" (emphasis added). Applicant submits that this assumption is false and unsupported by Machida and the other cited prior art.

Machida does not teach or suggest that double-sided tape can and should be replaced by catalyzed elastomeric adhesive. Machida's phrase *"or the like"* is insufficient to motivate one skilled in the art to replace double-sided tape with catalyzed elastomeric adhesive. Machida does not teach or suggest that elastomeric adhesive is a suitable alternative or equivalent to "double-sided tape." In summary, Machida fails to support the assumption that it would have been obvious to substitute the double-sided tape with catalyzed elastomeric adhesive in the claimed basketball backboard assembly.

Applicant further submits that it would ***NOT*** have been obvious to substitute double-sided tape with catalyzed elastomeric adhesive in the claimed basketball backboard assembly. If it were so obvious to substitute double-sided tape with catalyzed elastomeric adhesive, others would have done it long ago to achieve the beneficial results reported in the specification. The specification, pages 9 and 10 compares the adhesion and flexibility of conventional double-sided tape with catalyzed elastomeric adhesive within the scope of the present invention. The baseline adhesion and flexibility of double-sided tape was 20° deflection at 125 inch-pounds torque. Page 10, lines 14-15. The adhesion and flexibility of the catalyzed elastomeric adhesive was 25° to 45° deflection at 160 inch-pounds torque. Page. 10, lines 19-21. The improved adhesion and flexibility reported in the specification results in improved playability, longevity, and failure rate of basketball backboard systems in accordance with the present invention.

In addition, Applicant has observed with the manufacture of approximately 300,000 acrylic backboard basketball systems in the year 2000, that the manufacturing cost (materials and labor) of using catalyzed elastomeric adhesive to bond the acrylic backboard was approximately one-third the cost of using double-sided tape to bond the acrylic backboard. Again, if it were obvious to use elastomeric adhesive instead of double-sided tape, then others would have done so long ago to obtain manufacturing cost savings.[1]

The beneficial, unexpected, and surprising results obtained using catalyzed elastomeric adhesive compared to double-sided tape demonstrate that it would not have been obvious to substitute the double-sided tape with elastomeric adhesive. Accordingly,

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[1]If the Examiner believes it is necessary to submit this manufacturing cost savings evidence in a Rule 132 Declaration, please advise Applicant.

Applicant requests withdrawal of the rejection under Section 103(a) and allowance of claim 1.

Rejection of Claims 2-18 under Section 103(a). Paragraph 3 of the Office Action rejected claims 2-18 under Section 103(a) as being unpatentable over Hying et al., in view of Machida, Nunes, and 3M Data Sheet. Applicant respectfully submits that the pending claims would not have been obvious from the cited prior art.

Given the patentability of claim 1, as explained above, claim 2-18 are also patentable. According to MPEP 2143.03, "all the claim limitations must be taught or suggested by the prior art" to establish *prima facie* obviousness of a claimed invention.

In this case, the cited prior art does not teach or suggest the elastomeric adhesives of claims 1, 4, 5, 6, 14, and 15. Bond gap spacers of claims 7-10, 14, and 16-18 are not taught or suggested by the cited prior art.[2]

In view of the foregoing, Applicant submits that claims 2-18 are not properly rejected under Section 103(a). Applicant requests withdrawal of the rejection and allowance of claims 1-18.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made." Enclosed are replacement copies of product data sheets relating to silicone adhesives requested by the Examiner and which were previously submitted in Applicant's information disclosure statement dated April 21, 1999.

If there are any remaining issues preventing allowance of the foregoing claims, the Examiner is requested to telephone the undersigned.

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[2]The 3M Data Sheet citation discloses glass bubbles and spheres for use as fillers in applications such as spackling compound, reinforced thermoplastics, and autobody filler. It does not teach or suggest the use of glass beads as bond gap spacers.

Respectfully submitted,

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Version with markings to show changes made.

1. (amended) A basketball backboard assembly sized and configured for playing the game of basketball comprising:

a backboard frame structure having a bonding surface;

an acrylic backboard having a bonding surface; and

[an] a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball.

4. (amended) A basketball backboard assembly according to claim [3] 1, wherein the elastomeric adhesive is catalyzed silicone adhesive.

5. (amended) A basketball backboard assembly according to claim [3] 1, wherein the elastomeric adhesive is a two-part catalyzed adhesive in which the two parts are combined in a ratio to provide a set time in the range from about 7 to 15 minutes.

6. (amended) A basketball backboard assembly according to claim [3] 1, wherein the elastomeric adhesive is a two-part catalyzed adhesive in which the two parts are combined in a ratio to provide a set time in the range from about 5 minutes to 1 hour.

14. (amended) A basketball backboard assembly sized and configured for playing the game of basketball comprising:

a metal backboard frame structure having a bonding surface;

an acrylic backboard having a bonding surface; and

a catalyzed silicone adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the silicone adhesive has a bond gap in the range from about 2 to 2.5 mm, wherein the silicone adhesive is configured to provide a set time in the range from about 5 minutes to 1 hour, wherein the silicone adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball; and

a plurality of bond gap spacers located between the frame bonding surface and the backboard bonding surface to provide the bond gap.